UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,010	06/23/2003	Bruce Edward Stuckman	1033-T00531	7678

60533 7590 03/07/2007 TOLER SCHAFFER, LLP 8500 BLUFFSTONE COVE SUITE A201 AUSTIN, TX 78759	**EXAMINER** BASHORE, WILLIAM L

ART UNIT	PAPER NUMBER
2176	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/07/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

	Application No.	Applicant(s)
Office Action Summary	10/602,010	STUCKMAN ET AL.
	Examiner	Art Unit
	William L. Bashore	2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 November 2006*.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7,9-22 and 24-36* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7,9-22 and 24-36* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to communications: Appeal Brief filed 11/13/2006, to the original application

filed **6/23/2003**, IDS filed 10/20/2003.

2.   Please note that three independent sets of rejections under 35 U.S.C. 103(a) are applied to the instant

claims. First set begins at paragraph 6, second set at paragraph 9, third set at paragraph 12.

3.   Claims 1-7, 9-22, 24-36 pending. Claims 1, 24 are independent.

4.   In view of the Appeal Brief filed on 11/13/2006, PROSECUTION IS HEREBY REOPENED. New sets

of rejections are set forth below.

        To avoid abandonment of the application, appellant must exercise one of the following two options:

        (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if

this Office action is final); or,

        (2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief

under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new

appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously

paid, then appellant must pay the difference between the increased fees and the amount previously paid.

        A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

Heather R. Herndon
Supervisory Patent Examiner
Technology Center 2100

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set

forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the
> differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been
> ·obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall
> not be negatived by the manner in which the invention was made.

6.   **Claims 1-5, 7, 9, 12-13, 18, 24-28, 30-36 are rejected under 35 U.S.C. 103(a) as being unpatentable**

over OmniForm User's Manual (hereinafter OmniForm), 1999 CAERE Corporation, pages 1, 10-53, 95-

107, in view of Quality Reexamination Review Sheet (hereinafter QRRS), USPTO Revision 9/1990,

page 1.

In regard to independent claim 1, OmniForm teaches a method of converting a paper form to an

equivalent electronic form, capable of user input. It is noted that OmniForm teaches user control over a form's

design, said form edited accordingly (OmniForm pages 1, 14-18, 25-30, 95-107).

OmniForm teaches said form, once scanned and edited accordingly, said form can be displayed (posted)

on a computer, or in the alternative, can be published (posted) to the Web (OmniForm pages 49-53. It is noted

that users on the Internet can fill in a published form via OmniForm Internet Filler (OmniForm pages 52-53).

OmniForm does not specifically teach displaying *"criteria for infringement of a particular patent"*,

"accepting first user input to identify an infringement target", and accepting *"second user input to describe how*

the infringement target meets the criteria". However, QRRS is a USPTO quality review sheet comprising a

paper input form (page 1), said form comprising various question numbered 1-8 regarding criteria for

infringement, as well as accepting user entry of a Control Number (USPTO application number) which

identifies an infringement target. QRRS goes on to teach user inputted square "x" boxes, plus lines for inputting

explanations and/or comments, which is user input/confirmation of how said target meets the criteria. Since

OmniForm accepts a scanned paper form of any type, QRRS teaches towards OmniForm's method by providing

blank lines and boxes for conversion accordingly. It would have been obvious to one of ordinary skill in the art

at the time of the invention to apply QRRS to OmniForm, allowing OmniForm to convert the paper form of

QRRS into an equivalent, editable form so that users can easily enter electronic form data accordingly.

In regard to dependent claims 2, 3, 4, 5, 7, OmniForm by itself does not teach a plurality of adjacent

input boxes arraged in column fashion, etc. However QRRS teach a plurality of input lines and boxes, each

associated accordingly (QRRS page 1). It is noted that QRRS teaches display portions in a first column, and

input boxes in a second column, as well as accepting user input as a control no. (U.S. application number) for

target identification. It would have been obvious to one of ordinary skill in the art at the time of the invention to

apply QRRS to OmniForm, providing a user of OmniForm the benefit of user inputted explanations to multiple

issues.

In regard to dependent claim 9, OmniForm teaches a form, once scanned and edited accordingly, can

be displayed (posted) on a computer, or in the alternative, can be published (posted) to the Web (OmniForm

pages 49-53. It is noted that users on the Internet can fill in a published form via OmniForm Internet Filler

(OmniForm pages 52-53) (see also OmniForm page 46 – adding a SUBMIT button).

In regard to dependent claim 12, OmniForm teaches a form, once scanned and edited accordingly, can

be displayed (posted) on a computer, or in the alternative, can be published (posted) to the Web (OmniForm

pages 49-53. OmniForm does not teach, but QRRS teaches that its form is for entering of information

(submission) to be evaluated accordingly. It would have been obvious to one of ordinary skill in the art at the

time of the invention to apply QRRS to OmniForm, providing a user the benefit of filling and submitting an

electronic reexamination related form for convenience.

In regard to dependent claim 13, OmniForm does not specifically teach, but QRRS teaches a quality sheet associated with reexamination procedure by the USPTO. Although QRRS does not forcefully disclose evaluation by a patent attorney, nevertheless, since said form is evaluated by a technology center's Director's Office which has access to in-house legal advisors, it would have been obvious to one of ordinary skill in the art at the time of the invention for said form to be evaluated by a legal advisor for the benefit of dealing with legal issues associated with reexamination procedure.

In regard to dependent claim 18, OmniForm teaches mailing a form via e-mail to be filled and returned accordingly (OmniForm pages 40-43, 48). E-mail typically contains a date and time stamp. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply a date and time stamp of submission, providing the benefit of timely submissions in case of disputes, etc.

In regard to dependent claims 21, OmniForm teaches a form, once scanned and edited accordingly, can be published (posted) to the Web (OmniForm pages 49-53.

In regard to dependent claims 22, OmniForm teaches conversion from paper input areas to electronic input areas, which are generally considered graphical in nature.

In regard to independent claim 24, claim 24 reflects the article of manufacture comprising computer readable instructions used for performing the methods as claimed in claim 1, and is rejected along the same rationale.

In regard to dependent claims 25-28, 30, 32, claims 25-28, 30, 32 reflect the article of manufacture comprising computer readable instructions used for performing the methods as claimed in claims 2-5, 7, 9 respectively, and are rejected along the same rationale.

In regard to dependent claim 31, OmniForm does not specifically teach, but QRRS teaches natural language textual input (QRRS page 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply QRRS to OmniForm, providing a user of OmniForm the benefit of understandable analysis.

In regard to dependent claims 33, 34, OmniForm teaches conversion from manual input areas to electronic input areas, which are graphical in nature.

OmniForm teaches international language settings (OmniForm pages 19-21).

In regard to dependent claim 35, OmniForm does not specifically teach, but QRRS teaches a reexamination quality review sheet, which ensures trust in an examiner of record from entering non-useful information during prosecution. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply QRRS to OmniForm, providing increased reexamination quality control.

In regard to independent claim 36, claim 36 incorporates substantially similar subject matter as claimed in claim 1, and in further view of the following, is rejected along the same rationale.

OmniForm does not specifically recite "*wherein the infringement target information does not predate the filing date of the particular patent*". However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of the following. QRRS teaches a reexamination review sheet. It is well established in U.S. Intellectual Property law that the above quoted limitation is at least a basic rule of infringement. Infringement of a patent can only occur if the "infringement target information" does not

predate the filing date of said patent, therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this well known rule, providing the benefit of patent rights enforcement.

7.   Claims 6, 19, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over OmniForm in view of QRRS, and further in view of BountyQuest Website (hereinafter BountyQuest), <www.bountyquest.com>, 5/15/2001, downloaded via archive.org on 11/1/2005, pages 1-29 (listed in a previous action – please note that the examiner references page numbers at bottom of the BountyQuest reference).

    In regard to dependent claims 6, 29, OmniForm does not specifically teach a plurality of areas displaying infringement criteria portions (claim limitations), with each input box differentiated accordingly. However, BountyQuest teaches an input form for a user to enter information, including multiple input boxes for describing how the infringement target meets the criteria, one box per displayed infringement limitation (BountyQuest, page 16 section "Required Elements"). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply BountyQuest to OmniForm, providing a user a detailed way to solicit a contributing opinion in the form of an infringement description in an organized manner. It is noted that BountyQuest deals in the realm of IP infringement (see BountyQuest page 9, top paragraph).

    In regard to dependent claim 19, OmniForm does not teach, but BountyQuest teaches recordation of a session ID and timestamp, as well as instructions to print a copy of the confirmation page (BountyQuest page 15). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply BountyQuest to OmniForm, providing a user the benefit of receipts for confirming submissions.

8.   **Claims 10-11, 14-17, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over**

OmniForm in view of QRRS, and further in view of Utsumi, Yoshimasa (hereinafter Utsumi), European

Patent No. EP 1 160 708 A1, published December 5, 2001

        In regard to dependent claims 10-11, OmniForm does not teach, but Utsumi teaches identification of a

product, and a company (Utsumi para [0006], [0028]). It would have been obvious to one of ordinary skill in the

art at the time of the invention to apply Utsumi to OmniForm/QRRS, providing a user the benefit of efficient

target identification.

        In regard to dependent claims 14-17, OmniForm does not teach, but Utsumi teaches that a reward is

issued for a first on-point submission accordingly, along with deals, fixed and/or variable fees etc. (Utsumi para

[0037] to [0041]). It would have been obvious to one of ordinary skill in the art at the time of the invention to

apply Utsumi to OmniForm/QRRS, providing a user the benefit of better infringement submission via

incentives.

        In regard to dependent claim 20, OmniForm teaches posting on the Internet (OmniForm pages 49-53).

Utsumi teaches a suitable network (Utsumi para [0049], Figure 4 item 3), providing reasonable suggestion to

one of ordinary skill in the art at the time of the invention to utilize an intranet instead (intranet is contained,

while the Internet is global), providing the benefit of increased security for seeking infringement of classified

patents, etc.

9.   **Claims 1-5, 7, 9, 12-13, 18, 24-28, 30-36 are rejected under 35 U.S.C. 103(a) as being unpatentable**

over OmniForm User's Manual (hereinafter OmniForm), 1999 CAERE Corporation, pages 1, 10-53, 95-

107, in view of Quality Review Reexamination Part 1 – Practice & Procedures (hereinafter QRRP1),

USPTO Revision 9/1990, pages 1-2.

In regard to independent claim 1, OmniForm teaches a method of converting a paper form to an

equivalent electronic form, capable of user input. It is noted that OmniForm teaches user control over a form's

design, said form edited accordingly (OmniForm pages 1, 14-18, 25-30, 95-107).

OmniForm teaches said form, once scanned and edited accordingly, said form can be displayed (posted)

on a computer, or in the alternative, can be published (posted) to the Web (OmniForm pages 49-53. It is noted

that users on the Internet can fill in a published form via OmniForm Internet Filler (OmniForm pages 52-53).

OmniForm does not specifically teach displaying *"criteria for infringement of a particular patent"*,

"accepting first user input to identify an infringement target", and accepting *"second user input to describe how*

the infringement target meets the criteria". However, QRRP1 is a USPTO quality review sheet comprising a

paper input form (pages 1, 2), said form comprising various question numbered 1-8 regarding criteria for

infringement, as well as accepting user entry of a Control Number (USPTO application number) which

identifies an infringement target. QRRP1 goes on to teach user inputted square "x" boxes, plus lines for

inputting explanations and/or comments, which is user input/confirmation of how said target meets the criteria.

Since OmniForm accepts a scanned paper form of any type, QRRP1 teaches towards OmniForm's method by

providing blank lines and boxes for conversion accordingly. It would have been obvious to one of ordinary skill

in the art at the time of the invention to apply QRRP1 to OmniForm, allowing OmniForm to convert the paper

form of QRRS into an equivalent, editable form so that users can easily enter electronic form data accordingly.

In regard to dependent claims 2, 3, 4, 5, 7, OmniForm by itself does not teach a plurality of adjacent

input boxes arraged in column fashion, etc. However QRRP1 teach a plurality of input lines and boxes, each

associated accordingly (QRRP1 page 1). It is noted that QRRP1 teaches display portions in a first column, and input boxes in a second column, as well as accepting user input as a control no. (U.S. application number) for target identification. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply QRRP1 to OmniForm, providing a user of OmniForm the benefit of user inputted explanations to multiple issues.

In regard to dependent claim 9, OmniForm teaches a form, once scanned and edited accordingly, can be displayed (posted) on a computer, or in the alternative, can be published (posted) to the Web (OmniForm pages 49-53. It is noted that users on the Internet can fill in a published form via OmniForm Internet Filler (OmniForm pages 52-53) (see also OmniForm page 46 – adding a SUBMIT button).

In regard to dependent claim 12, OmniForm teaches a form, once scanned and edited accordingly, can be displayed (posted) on a computer, or in the alternative, can be published (posted) to the Web (OmniForm pages 49-53. OmniForm does not teach, but QRRP1 teaches that its form is for entering of information (submission) to be evaluated accordingly. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply QRRP1 to OmniForm, providing a user the benefit of filling and submitting an electronic reexamination related form for convenience.

In regard to dependent claim 13, OmniForm does not specifically teach, but QRRP1 teaches a quality sheet associated with reexamination procedure by the USPTO. Although QRRP1 does not forcefully disclose evaluation by a patent attorney, nevertheless, since said form is evaluated by a technology center's Director's Office which has access to in-house legal advisors, it would have been obvious to one of ordinary skill in the art at the time of the invention for said form to be evaluated by a legal advisor for the benefit of dealing with legal issues associated with reexamination procedure.

In regard to dependent claim 18, OmniForm teaches mailing a form via e-mail to be filled and

returned accordingly (OmniForm pages 40-43, 48). E-mail typically contains a date and time stamp. It would

have been obvious to one of ordinary skill in the art at the time of the invention to apply a date and time stamp

of submission, providing the benefit of timely submissions in case of disputes, etc.

In regard to dependent claims 21, OmniForm teaches a form, once scanned and edited accordingly,

can be published (posted) to the Web (OmniForm pages 49-53.

In regard to dependent claims 22, OmniForm teaches conversion from paper input areas to electronic

input areas, which are generally considered graphical in nature.

In regard to independent claim 24, claim 24 reflects the article of manufacture comprising computer

readable instructions used for performing the methods as claimed in claim 1, and is rejected along the same

rationale.

In regard to dependent claims 25-28, 30, 32, claims 25-28, 30, 32 reflect the article of manufacture

comprising computer readable instructions used for performing the methods as claimed in claims 2-5, 7, 9

respectively, and are rejected along the same rationale.

In regard to dependent claim 31, OmniForm does not specifically teach, but QRRP1 teaches natural

language textual input (QRRP1 page 1). It would have been obvious to one of ordinary skill in the art at the time

of the invention to apply QRRP1 to OmniForm, providing a user of OmniForm the benefit of understandable

analysis.

In regard to dependent claims 33, 34, OmniForm teaches conversion from manual input areas to electronic input areas, which are graphical in nature.

OmniForm teaches international language settings (OmniForm pages 19-21).

In regard to dependent claim 35, OmniForm does not specifically teach, but QRRP1 teaches a reexamination quality review sheet, which ensures trust in an examiner of record from entering non-useful information during prosecution. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply QRRP1 to OmniForm, providing increased reexamination quality control.

In regard to independent claim 36, claim 36 incorporates substantially similar subject matter as claimed in claim 1, and in further view of the following, is rejected along the same rationale.

OmniForm does not specifically recite *"wherein the infringement target information does not predate the filing date of the particular patent"*. However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of the following. QRRP1 teaches a reexamination review sheet. It is well established in U.S. Intellectual Property law that the above quoted limitation is at least a basic rule of infringement. Infringement of a patent can only occur if the "infringement target information" does not predate the filing date of said patent, therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this well known rule, providing the benefit of patent rights enforcement.

10.   **Claims 6, 19, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over OmniForm in view of QRRP1, and further in view of BountyQuest Website (hereinafter BountyQuest), <www.bountyquest.com>, 5/15/2001, downloaded via archive.org on 11/1/2005, pages 1-29 (listed in a previous action – please note that the examiner references page numbers at bottom of the BountyQuest reference).**

In regard to dependent claims 6, 29, OmniForm does not specifically teach a plurality of areas displaying infringement criteria portions (claim limitations), with each input box differentiated accordingly. However, BountyQuest teaches an input form for a user to enter information, including multiple input boxes for describing how the infringement target meets the criteria, one box per displayed infringement limitation (BountyQuest, page 16 section "Required Elements"). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply BountyQuest to OmniForm, providing a user a detailed way to solicit a contributing opinion in the form of an infringement description in an organized manner. It is noted that BountyQuest deals in the realm of IP infringement (see BountyQuest page 9, top paragraph).

In regard to dependent claim 19, OmniForm does not teach, but BountyQuest teaches recordation of a session ID and timestamp, as well as instructions to print a copy of the confirmation page (BountyQuest page 15). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply BountyQuest to OmniForm, providing a user the benefit of receipts for confirming submissions.

11.   **Claims 10-11, 14-17, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over OmniForm in view of QRRP1, and further in view of Utsumi, Yoshimasa (hereinafter Utsumi), European Patent No. EP 1 160 708 A1, published December 5, 2001**

In regard to dependent claims 10-11, OmniForm does not teach, but Utsumi teaches identification of a product, and a company (Utsumi para [0006], [0028]). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Utsumi to OmniForm/QRRP1, providing a user the benefit of efficient target identification.

In regard to dependent claims 14-17, OmniForm does not teach, but Utsumi teaches that a reward is issued for a first on-point submission accordingly, along with deals, fixed and/or variable fees etc. (Utsumi para [0037] to [0041]). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Utsumi to OmniForm/QRRP1, providing a user the benefit of better infringement submission via incentives.

In regard to dependent claim 20, OmniForm teaches posting on the Internet (OmniForm pages 49-53). Utsumi teaches a suitable network (Utsumi para [0049], Figure 4 item 3), providing reasonable suggestion to one of ordinary skill in the art at the time of the invention to utilize an intranet instead (intranet is contained, while the Internet is global), providing the benefit of increased security for seeking infringement of classified patents, etc.

12. **Claims 1-7, 9-22, 24-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Utsumi, Yoshimasa (hereinafter Utsumi), European Patent No. EP 1 160 708 A1, published December 5, 2001, in view of BountyQuest Website (hereinafter BountyQuest), <www.bountyquest.com>, 5/15/2001, downloaded via archive.org on 11/1/2005, pages 1-29 (listed in a previous action – please note that the examiner references page numbers at bottom of the BountyQuest reference).**

In regard to independent claim 1, Utsumi teaches a method of assessing possible patent infringement (Utsumi Abstract, para [0013]) whereby information is posted on a Website seeking possible infringement information regarding a particular patent, etc. (Utsumi para [0023], [0024], [0025]). If a user wishes to input a possible infringement target, he/she can do so via an input form (Utsumi para [0027], [0028], [0029], [0030]).

Utsumi teaches an input form field for inputting detailed infringement information (Utsumi para [0030]

window 23). Said window 23 is offered for input of infringement target information, with the size of said

window providing the capability of inputting as much information as may be necessary. It is also noted that

Figure 3 "Patent Number" (upper left corner) is carried over from Utsumi Figure 2 item 15, at least providing

criteria for infringement via at least the display of the patent number itself on the form of Figure 3. Utsumi also

teaches an embodiment which allows solicitation of opinions (Utsumi para. [0064]). Utsumi does not

specifically teach a second user input to describe how said target meets the criteria, or of indication of an

infringement target. However, BountyQuest teaches an input form for a user to enter information, including

multiple areas for describing how the infringement target meets the criteria (BountyQuest, page 16 section

"Required Elements"). Above this is an input window indicating "The article clearly describes a device for

changing hot lightbulbs with the hinges described in claim 5 of the..." (BountyQuest page 16

"Description/Comments")). The examiner fairly interprets this teaching as directed to the user identifying an

infringement target, or at the very least associated with an infringement issue (see also BountyQuest page 9, top

paragraph). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply

BountyQuest to Utsumi, providing Utsumi a detailed way to solicit a contributing opinion in the form of an

infringement description and target. Both references are in the same general field of endeavor, since both

references deal with solicitation of prior art, and both deal in the realm of IP infringement (see BountyQuest

page 9, top paragraph).

In regard to dependent claim 2, Utsumi teaches input boxes (Utsumi Figure 3). Utsumi does not

specifically teach a plurality of input boxes for the second input. However, BountyQuest teaches an input form

for a user to enter information, including multiple input boxes for describing how the infringement target meets

the criteria (BountyQuest, page 16 section "Required Elements"). It would have been obvious to one of ordinary

skill in the art at the time of the invention to apply BountyQuest to Utsumi, providing Utsumi a detailed way to

solicit a contributing opinion in the form of an infringement description in an organized manner. Both references

are in the same general field of endeavor, since both references deal with solicitation of prior art, and both deal in the realm of IP infringement (see BountyQuest page 9, top paragraph).

In regard to dependent claim 3, Utsumi teaches input boxes (Utsumi Figure 3). Utsumi does not specifically teach a plurality of input boxes for the second input, each box differentiated accordingly. However, BountyQuest teaches an input form for a user to enter information, including multiple input boxes for describing how the infringement target meets the criteria, one box per limitation (BountyQuest, page 16 section "Required Elements"). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply BountyQuest to Utsumi, providing Utsumi a detailed way to solicit a contributing opinion in the form of an infringement description in an organized manner. Both references are in the same general field of endeavor, since both references deal with solicitation of prior art, and both deal in the realm of IP infringement (see BountyQuest page 9, top paragraph).

In regard to dependent claim 4, Utsumi teaches input boxes (Utsumi Figure 3). Utsumi does not specifically teach a plurality of areas displaying infringement criteria portions, with each input box differentiated accordingly. However, BountyQuest teaches an input form for a user to enter information, including multiple input boxes for describing how the infringement target meets the criteria, one box per displayed infringement limitation (BountyQuest, page 16 section "Required Elements"). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply BountyQuest to Utsumi, providing Utsumi a detailed way to solicit a contributing opinion in the form of an infringement description in an organized manner. Both references are in the same general field of endeavor, since both references deal with solicitation of prior art, and both deal in the realm of IP infringement (see BountyQuest page 9, top paragraph).

In regard to dependent claims 5-6, Utsumi teaches input boxes (Utsumi Figure 3). Utsumi does not specifically teach a plurality of areas displaying infringement criteria portions (claim limitations), with each

input box differentiated accordingly. However, BountyQuest teaches an input form for a user to enter

information, including multiple input boxes for describing how the infringement target meets the criteria, one

box per displayed infringement limitation (BountyQuest, page 16 section "Required Elements"). It would have

been obvious to one of ordinary skill in the art at the time of the invention to apply BountyQuest to Utsumi,

providing Utsumi a detailed way to solicit a contributing opinion in the form of an infringement description in

an organized manner (i.e. columnar fashion, etc.). Both references are in the same general field of endeavor,

since both references deal with solicitation of prior art, and both deal in the realm of IP infringement (see

BountyQuest page 9, top paragraph).

In regard to dependent claim 7, Utsumi teaches an input box for inputting infringement information in

natural language text (Utsumi's Figure 3 accepts natural (i.e. English, etc.) language input).

In regard to dependent claims 9-11, Utsumi teaches a Web form (Utsumi para [0027]). Utsumi

teaches identification of a product, and a company (Utsumi para [0006], [0028]).

In regard to dependent claim 12, Utsumi teaches a submission judged (evaluated) by a server

management company (Utsumi papa [00028]).

In regard to dependent claims 13-17, Utsumi teaches judgment by a patent attorney (Utsumi para

[0037]). A reward is issued for a first on-point submission accordingly, along with deals, fixed and/or variable

fees etc. (Utsumi para [0037] to [0041]).

In regard to dependent claims 18, Utsumi teaches submission via e-mail, which contains a date and

time stamp. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply a

date and time stamp of submission, providing the benefit of timely submissions in case of disputes, etc.

In regard to dependent claim 19, Utsumi does not specifically teach a receipt. However, BountyQuest teaches recordation of a session ID and timestamp, as well as instructions to print a copy of the confirmation page (BountyQuest page 15). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply BountyQuest to Utsumi, providing Utsumi the benefit of receipts for confirming submissions.

In regard to dependent claims 20-21, Utsumi teaches a suitable network (Utsumi para [0049], Figure 4 item 3). Although an "intranet" is not specifically disclosed, Utsumi does teach said network as the Internet (Utsumi para [0024]), providing reasonable suggestion to one of ordinary skill in the art at the time of the invention to utilize an intranet instead (intranet is contained, while the Internet is global), providing the benefit of increased security for seeking infringement of classified patents, etc.

In regard to dependent claim 22, although Utsumi does not specifically teach "graphical" input, nevertheless, Utsumi teaches nearly any type of communication mechanism for reporting information, including e-mail (Utsumi para [0051]). Since it is well established that e-mail has the capacity of attaching files (i.e. a pdf file, which is an image based document, diagrams, etc.), it would have been obvious to one of ordinary skill in the art at the time of the invention to provide graphical input such as diagrams and/or pdf as an e-mail attachment, providing the benefit of allowing a wide range of input from various sources.

In regard to independent claim 24, claim 24 reflects the article of manufacture comprising computer readable instructions used for performing the methods as claimed in claim 1, and is rejected along the same rationale.

In regard to dependent claims 25-34, claims 25-34 reflect the article of manufacture comprising computer readable instructions used for performing the methods as claimed in claims 2-9, 22-23, respectively, and are rejected along the same rationale.

In regard to dependent claim 35, Utsumi teaches an account number input screen whereby an information provider inputs a bank account number or a credit card number of said information provider – "the number representing the account to which a consideration or a contingent fee for the provided information is transferred…" (Utsumi column 5 paragraph [0030]). Although Utsumi never recites a *"trust mechanism"*, nevertheless, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Utsumi's disclosure above. Since it is well established that credit card numbers are typically used for charging purposes, the providing of a credit card number at least suggests a form of "trust management". It is well within reason that the inputting of personal sensitive information such as bank numbers and credit card numbers can act as a deterrent against non-serious junk submissions. The implementation of such a deterrent provides the benefit of saving time and resources by not having to screen through non-useful information.

In regard to independent claim 36, claim 36 incorporates substantially similar subject matter as claimed in claim 1, and in further view of the following, is rejected along the same rationale. .

Utsumi does not specifically recite *"wherein the infringement target information does not predate the filing date of the particular patent"*. However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of the following. Utsumi teaches its invention with regard to infringement (Utsumi Abstract). It is well established in U.S. Intellectual Property law that the above quoted limitation is at least a basic rule of infringement. Infringement of a patent can only occur if the "infringement target information" does not predate the filing date of said patent., therefore, it would have been obvious to one

of ordinary skill in the art at the time of the invention to incorporate this well known rule, providing the benefit

of patent rights enforcement.

Response to Arguments

13.   Applicant's arguments filed 11/13/2006 have been fully and carefully considered but they are not

persuasive.

Applicant argues that BountyQuest teaches patent invalidation, as opposed to Utsumi's patent

infringement embodiment. Applicant asserts that the combination of the two references would at least render the

system unsatisfactory for its purpose of enabling efficient enforcement of patents.

The examiner respectfully disagrees. Applicant ignores BountyQuest's teaching (page 9 top paragraph –

referenced in the instant rejections) which recites in pertinent part: *"Lawyers whose clients have been sued or*

threatened with suit for patent infringement post in order to find prior art that may help them defend a case.".

Since infringement suits can be staggeringly high, it is well within reason that a patent rights holder can attempt

to find both infringement targets, and information that may invalidate its own patent. The success of an

infringement suit is based at least in part on the strength of the infringed patent against invalidation. If the

inventor can find prior art to invalidate its own patent, this would save the inventor/company the expense of a

full infringement suit, only to have the opposing party bring forward the same prior art.. Therefore, it would

have been obvious to one of ordinary skill in the art at the time of the invention to BountyQuest with Utsumi as

explained in the instant rejections.

Applicant argues that Utsumi teaches two different Web pages for entering information, as opposed to

Applicant's claimed limitation of *"An electronic form...etc."*.

The examiner respectfully disagrees. In additional support to the instant rejections, it is also noted that

Figure 3 "Patent Number" (upper left corner) is carried over from Utsumi Figure 2 item 15, at least providing

criteria for infringement via at least the display of the patent number itself on the form of Figure 3.

Conclusion

14.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to William L. Bashore whose telephone number is (571) 272-4088. The examiner can normally be reached on 11:30am - 8:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

15.   Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WILLIAM BASHORE
PRIMARY EXAMINER

March 4, 2007